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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,544	07/20/2001	Roberto Ayala	YOR920010274US1/I31-0004	2135
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CANTOR COLBURN LLP-IBM YORKTOWN			EXAMINER	
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Hartford, CT 06103			ART UNIT	PAPER NUMBER
			3627	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/910,544	<b>Applicant(s)</b> AYALA ET AL.	
	<b>Examiner</b> FAHD A. OBEID	<b>Art Unit</b> 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-25 and 39-69 is/are pending in the application.
- 4a) Of the above claim(s) 14-25 and 39-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of the Application***

1. **Claims 14-25 and 39-69** are pending in this application.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/16/2009 has been entered.

### ***Preliminary Remarks***

3. This is in reply to application filed on 09/16/2009.
4. Claims 14-25 and 39-69 are currently pending.
5. Claims 1-13 and 26-38 remain cancelled.
6. No claims have been added or cancelled.
7. Claims 53, 54, and 62 have been amended.
8. Claims 14-25 and 39-50 remain withdrawn as been drawn to nonelected invention.
9. Claims 51-69 are currently pending and have been examined.

***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 51-69 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

*Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

### **Claim Rejections - 35 USC § 103**

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**12. Claims 52, 54-58, and 62-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lidow (US 2002/0194057).**

13. As to claims 52, 54-58, and 62-66, Lidow shows aggregating demand received by an enterprise server, from enterprise site (comprising customers associated with the enterprise), the demand comprising materials requirements from each site (see e.g., para. 0018, lines 1-5; Fig. 6, 100; para 160); generating an unconstrained forecast from the aggregating (comprising summing the demand forecasts from the customers as in par. 0018, lines 5-8; Fig. 7, 138); transmitting the unconstrained forecasts to the suppliers (e.g., par. 0018, 8-11; par. 0019, 1-3; Fig. 6, 116, 118; Fig. 7, 142, Fig. 8, 154); receiving supplier capability statements from the suppliers (par. 0019, suppliers reply in lines 1-6; Fig. 7, 142; par. 0165, lines 13-18; Fig. 8, 154; par. 0166, lines 14-20); generating a squared set build plan that is site-specific build plan for each of the

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plurality of enterprise sites associated with the enterprise ( which is equivalent to customer intervention to resolve capacity issues such as imbalanced demand and supply; such that the server is unable to fulfill all the unconstrained demand with available supply, planners contact customers and suppliers to suggest adjustments to their respective production plans to create a better supply and demand balance for all parties; also, the server communicates with customers to ascertain any possible customer flexibility such as part substitutions, early or postponed delivery to thereby produce a new customer demand or constrained forecast; fig.6, col 8 lns 15-20, col 15 lns 30-45, col 15 lns 62-63, and col 16 lns 12-67); generating a constrained forecast (par. 0019, lines 6-7- customers change their demand forecast; Fig. 6, 120; Fig. 8, 158; par. 0167, lines 7-11 -a new demand forecast created which is constrained by supplier capabilities); transmitting the constrained forecast to the suppliers; generating a squared set build plan that is site-specific build plan for each of the plurality of enterprise sites associate with the enterprise (Upon a further determination that demand is greater than supply, the "supply chain server communicates with customers to ascertain any possible customer flexibility (e.g., part substitutions, early or postponed delivery) to thereby produce a new customer demand" para 0167).

Paragraph [0051] clearly shows aggregation and projected forecast from a group of customers (enterprise sites).

Paragraph [0167] shows that when demand is higher than capacity, there is a process for resolving the difference. One of the steps is to use customer intervention

158 to constrain the forecast in order to resolve the capacity/demand issue. One possibility disclosed is postponed delivery (equal or less to unconstrained forecast).

Lidow's Procurement Module formalizes the commitment or agreement made as a result of capacity/demand resolution.

Paragraph [paras 18, 152, 165-167] shows the unconstrained forecast does not take into consideration any resource constraints and the constrained forecasts are sent to only the suppliers who provided the formal commitment.

**14. Claims 51, 53, 59-61, and 67-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lidow (US 2002/0194057) in view of official notice.**

15. Regarding Claims 51, 53, 59-61, and 67-69: Lidow discloses all elements except for “that the received supplier capability statements are forwarded by the enterprise site”; “providing a formal commitment to produce the supply”; “generating a squared set build plan”; “using a constraint based optimization tool running a squared set analysis”; “producing a squared set build plan”; “inputting the build plan into an MRP tool”; and “using an MRP system to generate the forecasts”.

The Official Notice taken by the Examiner in the Office Actions mailed 06/30/2008, 08/09/2007, and 06/17/2005 is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of Official Notice or the traverse was inadequate (MPEP2144.03[C]).

The Examiner took Official Notice that it is notoriously old and well known to include “that the received supplier capability statements are forwarded by the enterprise site”; “providing

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a formal commitment to produce the supply”; “generating a squared set build plan”; “using a constraint based optimization tool running a squared set analysis”; “producing a squared set build plan”; “inputting the build plan into an MRP tool”; and “using an MRP system to generate the forecasts” (hereinafter Admitted Prior Art).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the above features enabled. For the advantage of providing a formal commitment in order to provide evidence of a meeting of the minds and to clarify communications; also, for the advantage of producing a material needs forecast and providing a more efficient use of resources.

### ***Response to Arguments***

16. Applicant's arguments have been fully considered but they are not persuasive. In particular the applicant argues that: a) Lidow does not teach the generation of a squared set build plan and the implementation of the MRP to generate the constrained and unconstrained forecasts. .

In response to a) examiner respectfully disagrees. Firstly, the applicant has not provided a timely traversal of the official notice taken by the examiner in the previous four office actions.

*“A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, the applicant is charged with rebutting the well known statement in the next reply after the office action in which the well known statement was made” MPEP 2144.03.*

Secondly, the applicant must rebut the official notice. This means that arguments must be presented as to why the officially noted fact is not the same as the claim limitation. A mere request for documentation is not a rebuttal.

*To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241; In re Boon, 169 USPQ 231.*

17. Lidow teaches that “the supply chain server receives forecasts from the customers detailing the orders that the customer desire” (para 0018), also (fig. 6 data flow 100, and paras 0152 and 0160). After receiving the forecasts, they are “consolidated, translated into supplier part numbers, and transformed into specific supplier requirements” (para. 0152) and (fig. 6, activity 112, and fig. 7 steps 130, 134, 136, and 138, and paras 0163-0165).

These consolidated forecasts for specific supplier requirements are the unconstrained forecasts that do not take into consideration any resource constraints.

Lidow also states that the forecasts from the customers are validated (“analyzed by the supply chain server to ensure that they conform to contractual agreements and do not contain errors” para 0018), they are not constrained in the context of this process. The claimed process and the process of Lidow deal with providing unconstrained forecasts, checking the capability of the suppliers to provide the requested items, and providing constrained forecasts based on the capability of the suppliers to provide the requested items.

The consolidated unconstrained forecasts do not take into consideration any resource constraints are then transmitted to the suppliers in order to determine whether the forecast demand is greater than the supplier's capacity.

Lidow states, "The supply chain server queries whether the aggregated customer demand is greater than the supplier capacity. Supplier capacity may be determined from data supplied by the suppliers to the server or by suppliers allowing access to their respective databases "(para 0165).

Upon the determination that demand is greater than supply, the Lidow begins the "constrained supply planning routine" (para 0166) shown in fig. 8.

If demand cannot be successfully redistributed and it is determined that demand is still greater than supply, intervention with the suppliers occurs (fig. 8 step 154, para 0166) it is noted that the content of the forecasts is further communicated to the suppliers in this step.

Upon a further determination that demand is greater than supply, the "supply chain server communicates with customers to ascertain any possible customer flexibility (e.g., part substitutions, early or postponed delivery) to thereby produce a new customer demand" (para 0167).

This new customer demand provides the constrained forecast since it is the result of and is constrained by the capability of the supplier to provide the part (fig. 6 data flow 120, fig 8 step 158, and para 0019 lines 6-7).

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After the resolution of the supply issues, "when supply issues have been resolved, the customer's demands are sent to the suppliers in groups so that the suppliers need to prepare a smaller number of large orders" (para 0019).

In allocate supply routine, "the parts which actually are available from suppliers (constrained parts) are allocated equally among the demanding customers"(paras 0166-0167).

Therefore, Lidow still meets the scope of the limitation as currently claimed.

### ***Conclusion***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FAHD A. OBEID whose telephone number is (571)270-3324. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fahd A Obeid/  
Examiner, Art Unit 3627  
November 4, 2009

/F. Ryan Zeender/  
Supervisory Patent Examiner, Art Unit 3627